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CAM No.: **305158-999171 (6750-173-999)**

Operator's Initials

Re: Application of: **Donald J. KYLE et al.**
Application No.: **10/607,563**
Filed: **June 27, 2003**
Title: **THERAPEUTIC AGENTS USEFUL FOR TREATING PAIN**
Examiner: **Paul V. Ward**
Confirmation No.: **5149**
Group Art Unit: **1624**
Attorney Docket No.: **6750-173-999 (CAM No.: 305158-999171)**

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Message:

A Statement of the Substance of the Interview conducted November 13, 2006 is enclosed for formal entry into the file of the above-identified application.

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NYJD-1643723v2

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Donald J. KYLE et al.

Confirmation No.: 5149

Application No.: 10/607,563

Group Art Unit: 1624

Filed: June 27, 2003

Examiner: Paul V. Ward

Title: THERAPEUTIC AGENTS USEFUL
FOR TREATING PAINAttorney Docket No.: 6750-173-999
(CAM No.: 305158-999171)STATEMENT OF THE SUBSTANCE OF THE INTERVIEWCommissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants' representative thanks Examiner Paul Ward for the courtesy of a telephonic interview in connection with the above-identified application. Pursuant to 37 C.F.R. § 1.133 and M.P.E.P. § 713.04, Applicants submit the following statement of the substance of a telephonic interview held on November 13, 2006 between Examiner Paul Ward and Applicants' representative Shahrokh Falati in connection with the above-identified application.

The Office Action mailed October 20, 2006 ("Office Action") was discussed to clarify (1) which claims are in the application, (2) which claims are allowable, and (3) which claims can be rejoined.

First, Mr. Falati pointed out that new claims 237-273, each (except for claim 237) depending directly or indirectly from claim 21, were added in an AMENDMENT AND PROVISIONAL ELECTION UNDER 37 C.F.R. § 1.143 WITH TRAVERSE AND STATEMENT OF THE SUBSTANCE OF THE INTERVIEW filed on March 22, 2006. The

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By:

Shahrokh Falati

(Reg. No. 58,160)

NYJD-1643163v2

March 22, 2006 Amendment was received and is of record in the file - see 03-22-2006 entries "Response to Election/Restriction Filed," "Specification," "Claims" and "Applicant Arguments/Remarks Made in an Amendment" in the PAIR Image File Wrapper for the above-identified application. However, the Office Communication with a restriction requirement mailed July 11, 2006 ("Restriction Requirement") did not acknowledge or discuss claims 237-273.

Second, Mr. Falati pointed out that in response to the Restriction Requirement, Applicants filed an AMENDMENT AND PROVISIONAL ELECTION UNDER 37 C.F.R. § 1.143 WITH TRAVERSE dated July 24, 2006, in which claims 237-273 were also present. The July 24, 2006 Amendment was received and is of record in the file - see 07-24-2006 entries "Response to Election/Restriction Filed," "Specification," "Claims" and "Applicant Arguments/Remarks Made in an Amendment" in the PAIR Image File Wrapper for the above-identified application. However, the Office Action still does not acknowledge or discuss claims 237-273 or their status.

Applicants' representative requested the Examiner's agreement that claims 237-273 are of record in the above-identified application and, accordingly, should be added to the claims already appearing on line 4 of the Office Action Summary. Examiner Ward acknowledged this.

Third, Mr. Falati pointed out that the Office Action states the compounds and compositions in Group I (claims 1-22 and 102-105) were allowed. However, claims 238-273, each of which depends directly or indirectly on claim 21 in the Group I allowed claims were not indicated as (1) part of Group I and (2) allowed.

Applicants' representative requested the Examiner's agreement that claims 238-273, which depend on allowed claim 21 of Group I, should be part of Group I, allowed, and, accordingly, should be added to the claims already appearing on line 5 of the Office Action Summary. Examiner Ward acknowledged this.

Fourth, Mr. Falati pointed out that in the AMENDMENT AND PROVISIONAL ELECTION UNDER 37 C.F.R. § 1.143 WITH TRAVERSE dated July 24, 2006, Applicants canceled without prejudice claims 132-191. As discussed above, the July 24, 2006 Amendment was received and is of record in the file of the above identified application.

Applicants' representative requested the Examiner's agreement that claims 132-190 are no longer of record in the above-identified application and, accordingly, should not appear on line 4 of the Office Action Summary. Examiner Ward acknowledged this.

Fifth, Mr. Falati pointed out that in the AMENDMENT AND PROVISIONAL ELECTION UNDER 37 C.F.R. § 1.143 WITH TRAVERSE dated July 24, 2006, Applicants neither canceled nor amended claims 192-236. As discussed above, the July 24, 2006 Amendment was received and is of record in the file of the above identified application.

Applicants' representative requested the Examiner's agreement that claims 192-236 are of record in the above-identified application and, accordingly, should be added to the claims already appearing on line 4 of the Office Action Summary. Examiner Ward acknowledged this.

In view of the many discrepancies between the status of the claims acknowledged by Examiner Ward and the status of the claims stated in the Office Action, Mr. Falati further requested of the Examiner that:

- (1) the Office Action would be rescinded,
- (2) a new Office Action would be mailed,
- (3) claims 1-131 and 192-273 would appear on line 4 of the new Office Action Summary,
- (4) claims 1-22, 102-105 and 238-273 would appear on line 5 of the new Office Action Summary; and
- (5) the "Detailed Action" section of the new Office Action would be revised pursuant to (3) and (4) above.

Examiner Ward indicated that he will consider sending a new Office Action.

Sixth, Mr. Falati raised the issue of the rejoinder of method claims which are commensurate in scope with the claims of Group I. Mr. Falati pointed out that in the Restriction Requirement on page 5, the Examiner stated that if "product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder."

The Office Action allowed the Group I "product" claims and, on page 2, welcomed Applicants to file an Amendment to rejoin the method claims commensurate in scope with the Group I claims. Mr. Falati pointed out that the following method claims are believed to be eligible for rejoinder:

- Method claims 117, 192 and 222, each depending on allowed claim 1;
- Method claims 118, 193 and 223, each depending on allowed claim 19;
- Method claims 119, 194 and 224, each depending on allowed claim 21;
and
- Method claims 120, 195 and 225, each depending on allowed claim 22.

Applicants' representative requested the Examiner's agreement that, claims 117-120, 192-195 and 222-225 would be allowed and rejoined. Examiner Ward indicated that the request to rejoin these claims should be made in Applicants next response.

Finally, Applicants respectfully request that the above statement be made of record in the above-identified application.

No fee is believed to be due for this response. Should any fee be required, please charge such fee to Jones Day Deposit Account No. 50-3013.

Date: November 14, 2006

Respectfully submitted,

*Samuel B. Abrams by
George A. Smith 42,140*
Samuel B. Abrams (Reg. No. 30,605)

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